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IN THE

SUPREME COURT OF THE UNITED STATES.

No. 1106

DEMPSTER BROTHERS, INC., et al.,
Petitioners,

vs.

BUFFALO METAL CONTAINER CORPORATION, et al.,
Respondents.

PETITION FOR A WRIT OF CERTIORARI

To the United States Court of Appeals for the Second Circuit.

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To the United States Court of Appeals for the Second Circuit.

Petitioners, Dempster Brothers, Inc. and Trust Company of Georgia, pray that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit in the above-entitled case.

OPINIONS BELOW.

The opinion of the Court of Appeals is reported at 352 F. (2d) 420, and is reprinted in the Appendix, *infra*, p. 5a. The opinion of the District Court for the Western District of New York was not reported but is printed in the Appendix, p. 15a *infra*.

JURISDICTION.

The judgment of the Court of Appeals was entered on November 3, 1965. A timely petition for rehearing *en banc* was denied on December 13, 1965 (App. p. 14a *infra*).

The jurisdiction of this Court is invoked pursuant to Title 28, U. S. Code, § 1254 (1). The basis of jurisdiction of the District Court was Title 28, U. S. Code § 1338 (a).

QUESTIONS PRESENTED.

As to Certiorari:

Should not this Court, which has not since 1937[1] expressed itself on the quantum of proof requisite to establish an invalidating prior use of a patented invention, now resolve a conflict between the decision of the Court of Appeals below and decisions of Courts of Appeals of other Circuits, based on early decisions of this Court, as to the sufficiency of proof required for establishment of prior use of a patented invention?

On the Merits:

1. Is the testimony of a single witness, uncorroborated and without contemporaneous documentary evidence, sufficient in law to establish prior use of a patented invention?

2. Should a patent for an otherwise new and patentable combination be held invalid as "obvious" (§ 103 of Title 35, U. S. C.), in view of a prior use sought to be established by uncorroborated testimony of a single witness?

INTRODUCTORY STATEMENT.

In nearly thirty years this Court has not considered, on the merits, a case concerning the character of proof necessary to establish prior use of a device relied upon to establish invalidity of a patent.

In 1937, the Court decided **Smith v. Hall**, 301 U. S. 216, 222, 57 S. Ct. 711, 714. The Court there reaffirmed earlier decisions in **Eibel Process Co. v. Minnesota & Ontario Paper Co.** (1923), 261 U. S. 45, 43 S. Ct. 322; **Deering v. Winona Harvester Works** (1894), 155 U. S. 286, 15 S. Ct. 118; and **The Barbed Wire Patent** (1892), 143 U. S. 275, 12 S. Ct. 443. In those cases, the Court laid down strict requirements of proof of prior use in patent cases, requir-

[1] Smith v. Hall (1937), 301 U. S. 216, 222, 57 S. Ct. 711, 714.

ing proof beyond a reasonable doubt, and ruling that uncorroborated oral testimony is insufficient in law.[2]

The plea of prior use arises in a very large percentage of suits for patent infringement, being almost as commonly pleaded as the defense of prior patents. Both are prescribed as defenses by the same Section 102 (a) in the 1952 Patent Statute (U. S. Code, Title 35, § 102).

Therefore, it is a matter of great public importance that this Court update the controlling law as to the kind and character of proof of a prior use requisite to invalidate a patent under Sections 102 and 103 of Title 35, U. S. Code. The decision of the Court below is in conflict with decisions in other circuits which are based on earlier decisions of this Court:

Zachos v. Sherwin-Williams Co. (5th Cir., 1949), 177 F. (2d) 762;

Cold Metal Products Co. v. E. W. Bliss Co. (6th Cir., 1960), 285 F. (2d) 244;

Devex Corp. v. General Motors Corporation (7th Cir., 1963), 321 F. (2d) 234 (cert. den., 375 U. S. 971);

National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co. (8th Cir., 1901), 106 Fed. 693;

Jamco, Inc., v. Carlson (10th Cir., 1959), 274 F. (2d) 338.

We shall show in this Petition that this case furnishes an ideal opportunity for this Court by granting Certiorari, to reexamine the legal principles from which the Second Circuit has departed, and to prescribe current guidelines for acceptable proof of a prior use. By doing so, this Court can reconcile the conflict between the standard of

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[2] **Smith v. Hall,** *supra*

"This oral testimony, if taken at its face value, would show that the Smith method was used in the Brooklyn incubator with eggs in staged incubation. **But without corroboration, it is insufficient to establish prior use.**"

(p. 222 of 301 U. S.)

proof accepted by the Second Circuit in this case and the standard of proof applied in other circuits on the same issue. The rules of this Court indicate this to be a proper basis for the grant of Certiorari (Rule 19, 1 (b)).[3]

Moreover, this case affords an opportunity for this Court, by granting Certiorari, to indicate positively that the prima facie validity prescribed by statute (Title 35, U. S. C., § 282) is not overcome by "hindsight" determinations that the invention was "obvious" from an insufficiently established asserted prior use device.

STATUTES INVOLVED.

This case involves Sections 101, 102, 103 and 282 of the Patent Act of 1952 (U. S. Code, Title 35, §§ 101, 102, 103 and 282). These provisions are set forth in the appendix beginning at page 1a, infra.

STATEMENT OF FACTS.

Petitioner, Dempster Brothers, Inc., is a manufacturer in Knoxville, Tennessee, of truck mounted refuse handling equipment, hereinafter sometimes referred to as the C-A (clearance arm) front end loaders and detachable containers. Respondent, Buffalo Metal Container Corporation, Buffalo, New York, has been a manufacturer, since 1959, of truck mounted front end loaders and detachable containers for handling refuse.

In 1959, patent No. 2,900,096 was issued to the petitioner, Dempster Brothers, Inc., and George R. Dempster (R. 327).[4]

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[3] "(b) Where a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter".

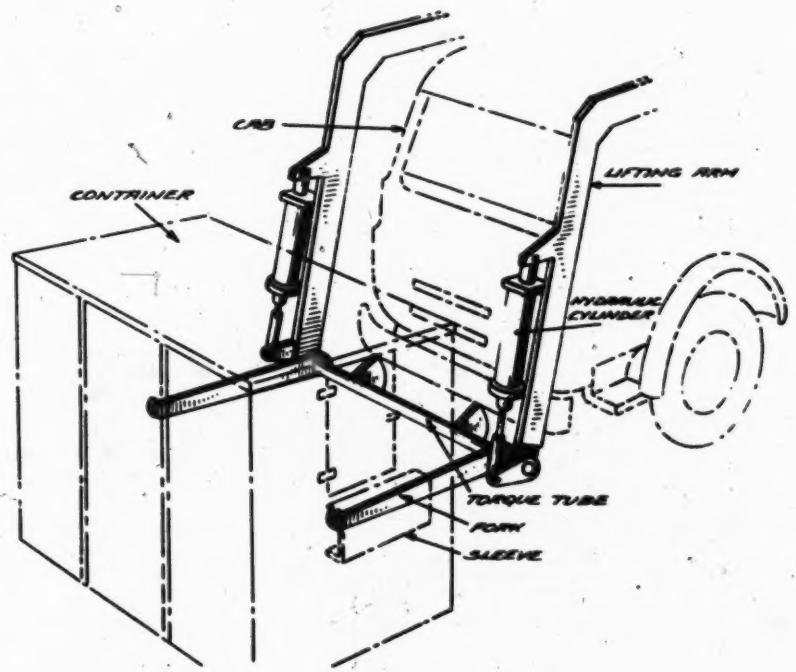
[4] The record references are to the printed record for the Court of Appeals.

The Court below found that this patented C-A loader represents a patentable combination.[5] This question, so often argued before this Court, is undisputed and not involved.

The Defendant has conceded infringement (R. 3); indeed it copied the patented equipment.

The device in the patent includes a container pick-up and dumping assembly, according to claims 6, 8, 9 and 20, based on Fig. 8 of the patent drawings, and according to the commercial embodiment thereof (Ex. P-13) is illustrated below:

PICK-UP AND DUMPING ASSEMBLY.



[5] "The C-A model represented a significant improvement over the H-O. Indeed, we do not understand Buffalo to contend that the C-A loader would not have been patentable, had there been no other developments in the field subsequent to 1953."

As briefly described in the opinion of the District Court (R. 3), the refuse container, which is specially designed, has open-ended sleeves on opposite ends of the container parallel with the base, but spaced about midway of the height of the container. A pair of lifting arms are mounted on the chassis at opposite sides of the truck to swing vertically to raised and lowered positions.

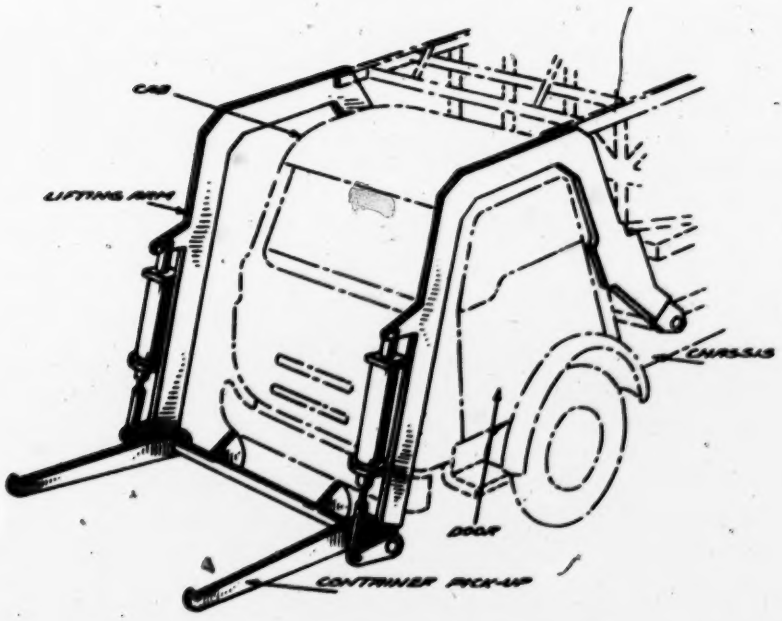
A torque tube extends transversely between the front ends of these lifting arms and is rotatable with respect thereto. Forks are mounted on opposite ends of the torque tube so as to be raised or lowered by rotation of the torque tube by manipulation of the hydraulic cylinders connected with the latter.

The truck which has a compaction body is driven up to the container and the forks enter the sleeves on the ends of the container. Then, upon raising movement of the lifting arms they lift the container over the cab of the truck to the body. Upon further rotation of the torque tube by the hydraulic cylinders, the container is turned upside down for dumping its contents into the truck body.

The lifting arms are mounted on the chassis frame behind the cab. The patented device provides a new form of lifting arms of gooseneck shape (it is undisputed that these are new) extending above the doors and over the cab and down in front of the cab to the level of the chassis frame, which is the point of engagement with the container.

This safety device as a combination is defined by claims 5, 14, 15, 16, 18 and 19, as illustrated below:

SAFETY DEVICE.



In the prior art front end loaders, the lifting arms would sweep past the doors and windows in the cab, causing grave danger of injury to a driver if he should have his arm or head out of a side of the cab, or if a door should be open it would be struck by the sweeping movement of the arm.

It is undisputed that the C-A loader was the first device to solve that problem successfully, avoiding injury to the driver and damage to the doors in the raising and lowering of the lifting arms.[6] The District Court so found (R. 6). Noting that this is a material improvement, the

[6] "The 'Clearance Arm,' or 'C-A' loader, the subject of the disputed patent, was developed by Dempster to cure these and other deficiencies. The principal advantages of this new model were: (1) the gooseneck arrangement of the arms over the cab provided added safety for the driver, making it impossible for him to be 'pinned' inside the cab at any stage of the dumping procedure; (2) the rigid arms gave the operator of the truck continuous control throughout the dumping procedure; . . ." (Infra, p. 7a).

Court below held that it represented a patentable invention.

Nevertheless, the District Court held all claims in suit to be invalid because of certain prior use devices, but entered no findings of fact as such, except as contained in his opinion.

In affirming that decision, the Court of Appeals refused to remand the case for more detailed findings, but it did modify to some extent the basis for the decision. The Court found that the device constituted a patentable invention, except that the patent was barred by certain prior use devices.

As set out in the decision of the Court of Appeals, the Container Pick-Up and Dumping Assembly of the patented device, responding to claims 6, 8, 9 and 20, was held to be anticipated by two separate instances of prior use, one by James E. Barnes; and another by S. Vincen Bowles.

The Safety Device, as a combination of the clearance arms with the cab and doors, was held to have been "obvious" from a third prior use device of Western Body & Hoist Company.

These three instances of prior use have in common a complete lack of corroborating evidence. In each instance, the Court relied upon the testimony of one man alone for the device allegedly built and used prior to the effective date of the patent.

Mr. Barnes testified in open court as to one prior use device. The opinion of the Court below, although discarding the pretended documentary evidence, relied solely on Barnes' testimony, without corroboration of any kind, either documentary or oral.[7]

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[7] "And, while Barnes admitted on cross-examination that the truck had been out of his possession for a period of time and the forks had been repaired, in response to questioning by the court he adhered to his earlier testimony that the photographs

Mr. Bowles testified by deposition as to another prior use device. Although testimony of a second witness, Leon Mick, was taken also by deposition as to the same device, it was so inconsistent with Mr. Bowles' testimony that neither Court below relied upon the inconsistent testimony of Mr. Mick, who did not corroborate Mr. Bowles.[8] No documentary evidence was produced or relied upon as to the character of the prior use device.

Mr. Livesley testified partly in open court and partly by depositon as to certain units allegedly built by Western Body & Hoist Company, but no other witness was produced, either to corroborate Mr. Livesley or to establish the authenticity of certain documents that were offered. Neither Court below found that the documents were authentic, but both Courts indicated reliance on the oral testimony.

The adequacy of proof as to these three instances of public use is crucial. Without it, the Court of Appeals found that the device is patentable.

REASONS FOR GRANTING THE WRIT.

I. As to Certiorari Policy.

This Court has not heard a patent case involving the issue of sufficiency of proof of prior use for nearly thirty years. Most of the lower courts continue to follow this Court's earlier pronouncements culminating in **Smith v. Hall** (1937), 301 U. S. 216, 57 S. Ct. 711; however, the

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were reasonable representations of the truck he purchased in January 1956. The court's 'complete satisfaction' with the proof of the prior art, including the Barnes loader, implies a finding that Barnes' testimony was credible, notwithstanding inconsistencies."

[8] "Bowles stated that in 1955 he built loaders also employing hydraulically actuated forks fitting into sleeves on detachable containers and sold them to Lawndale Disposal Co. and Antelope Rubbish Co. He too identified non-contemporaneous photographs as accurate portrayals of the relevant portions of the loaders as they existed in 1955."

decision below is in direct conflict with other circuits and with decisions of this Court. The public interest requires a resolution of this conflict in this important branch of the law.

The decision of the Second Circuit would open the door for fraud. Unscrupulous copyists need only to persuade a witness to testify convincingly,[9] in order to take patent property without due process of law. Patent rights are basic, protected by the Constitution,[10] and ought not to be subject to destruction without conclusive proof.

Decision below, in accepting a non-contemporaneous photograph as corroboration of oral testimony as to a device allegedly used in 1956, is in direct conflict with a decision of another Court of Appeals.

The Court below in accepting Barnes' oral testimony relied upon a photograph as "documentation of the purchase in January, 1956, of the truck relied upon.[11] This photograph was not established as to date by any com-

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[9] "In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory, and beyond a reasonable doubt. * * * Indeed, the frequency with which testimony is tortured, or fabricated outright, to build up the defense of a prior use of the thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer."

(The Barbed Wire Patent, 143 U. S. 275, 284, 12 S. Ct. 443, 447).

[10] Art. 1, § 8.

[11] "In any event, the record is not devoid of documentation, albeit non-contemporaneous. Barnes unequivocally identified a 1963 (1956) photograph of another Reo truck which he had purchased from Cook, in April or May 1956, as substantially similar in appearance to his January 1956 purchase."

petent evidence, and was admitted in evidence only "as reasonable representation" of the trucks (R. 266).

The Court, after printing, interlined in the opinion the date—1956—instead of 1963 for the non-contemporaneous photograph of a different Cook truck, apparently in reliance on Barnes' testimony that this photograph "would have been taken approximately May of 1956" (R. 261). We called this to the attention of the Court of Appeals, but that Court refused to delete the amendment.

In accepting Barnes' testimony of the date of a photograph used to corroborate his own testimony, the Court of Appeals compounds the error. Not even the District Court went so far.

If Barnes' testimony is insufficient without corroboration, it is not strengthened by his identification of an admittedly subsequent photograph.

The only other allegedly documentary evidence produced by Barnes was properly discarded by the Court below because it did not identify the nature of the loader allegedly built.[12]

Also, in connection with the Bowles loader, the Court referred to 1963 photographs.[13]

To the extent that the Court below relied upon the non-contemporaneous photographs for corroboration, the decision is in direct conflict with **National Hollow Brake-Beam**

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[12] "Other documentary evidence of the purchase was also introduced: a conditional sales agreement for the Reo vehicle, a letter from the motor vehicle department, and a motor vehicle registration form. But, since the descriptions of the vehicle referred to in these exhibits are vague, we place little reliance on them."

(Court Opinion, Footnote 4).

[13] "Dempster argues that even if the Barnes and Bowles loaders existed as depicted in the 1963 photographs."

Co. v. Interchangeable Brake-Beam Co. (8th Cir., 1901), 106 Fed. 693, 703.[14]

Clearly, photographs made after the event cannot corroborate oral testimony as to the nature of the specific trucks allegedly used in January, 1956.

The Court in the **Brake-Beam** case rejected the oral testimony and the "presently prepared pictures", in reliance on this Court's earlier decisions. The decision below is in definite conflict therewith.

Decision below is in conflict with decisions of other Courts of Appeals, and of this Court, in accepting oral testimony as sufficient proof of prior use.

This case represents a marked departure by the Second Circuit from the requirements, set many years ago by this Court, for corroboration of oral testimony in support of proof of prior use. The opinion below, furthermore, is inconsistent with decisions in other circuits on the same issue.

In **Zachos v. Sherwin-Williams Co.** (5th Cir., 1949), 177 F. (2d) 762, 763, the Court of Appeals rejected oral tes-

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[14] "The solemn grants of great franchises cannot be stricken down by testimony so flimsy and unsatisfactory. The memory of men is too brief and fleeting, too easily swayed by chance and by interest, to permit the recollection of one or two witnesses, prompted by **presently prepared pictures of the proof desired,** to condition the validity of valuable patents that have stood unchallenged for years. Unsupported oral testimony of a prior use is always open to suspicion, and it cannot prevail over the legal presumption of validity which accompanies the patent, unless it is sufficient to establish such a use beyond a reasonable doubt. The testimony relative to the use of this Wabash beam is not of that character, and it will not be further considered. * * *

"For the same reason the evidence of the use in 1884 and earlier of a double trussed wooden beam on the Burlington Railroad must be disregarded. It consists of the testimony of three witnesses, a drawing bearing the date of August 4, 1882, and several blue prints, which were evidently made after the patents to Hien were issued."

timony not supported by adequately proven documentary evidence.[15]

In so holding, the Fifth Circuit followed previous decisions of this Court, including **Smith v. Hall**, *supra*, and **The Barbed Wire Patent**, *supra*. The decision below of the Second Circuit is in direct conflict with the decision of the Fifth Circuit, and early decisions of this Court, which conflict this Court alone can resolve.

In **Cold Metal Products Co. v. E. W. Bliss Co.** (6th Cir., 1960), 285 F. (2d) 244, 247, the Sixth Circuit rejected, as being insufficient to prove prior use, the oral testimony of the witnesses, who testified several years after the alleged events and from recollection without corroborating documentary evidence.[16] In so holding that Court likewise cited and relied upon the previous decisions of this Court in **Smith v. Hall**, *supra*, and **The Barbed Wire Patent**, *supra*.

The Seventh Circuit reviewed and followed **Smith v. Hall**, *supra*, and rejected the alleged proof of prior use for lack of contemporaneous records, in **Devex Corp. v. General Motors Corporation** (7th Cir., 1963), 321 F. (2d) 234, 239 (cert. den., 375 U. S. 971).[17]

The view of the Eighth Circuit on this matter is expressed in the landmark case of **National Hollow Brake-**

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[15] "This rule is that prior use must be proved beyond a reasonable doubt, and that as a practical matter, it may be said that **oral testimony alone, unsupported by writings, has not been, and will not be accepted as sufficient.**"

[16] "It is well settled that the party attacking the validity of a patent on the ground that it is anticipated by prior use, has the burden of proving such prior use by clear, satisfactory evidence beyond a reasonable doubt. * * * **Oral testimony, without corroboration, is open to suspicion and is insufficient to establish prior use.**"

[17] "* * * the Court cites with approval a number of cases for the proposition, the burden of proof is upon the party setting it up and 'every reasonable doubt should be resolved against him.' Indeed, the late Chief Judge Learned Hand

Beam Co. v. Interchangeable Brake-Beam Co. (8th Cir., 1901), 106 Fed. 693, 703, where the Court rejected the testimony of even several corroborating witnesses based on non-contemporaneous blueprints, which, like the 1963 photographs relied upon by the Second Circuit Court below, were prepared after the suit was filed. The opinion of the Eighth Circuit by the eminent Judge Sanborn relied upon decisions of this Court, including **The Barbed Wire Patent case**, *supra*.

In the Tenth Circuit, the Court reviewed this issue in **Jamco, Inc. v. Carlson** (10th Cir., 1959), 274 F. (2d) 338, 340, rejecting the uncorroborated testimony of several witnesses not supported by contemporaneous records and again citing **Smith v. Hall**, *supra*. The Court conceded the credibility of the witnesses, recognizing that it is not a matter of credibility but of legal sufficiency of proof.[18]

The decision below, on the other hand, rejected petitioner's arguments because of the District Court's holding

> "that Barnes' testimony was credible notwithstanding inconsistencies. For us to reject this assessment of credibility out of hand would be to invade the province of the trier of fact".

As we have seen from the decisions in at least half of the other Circuits, supported by decisions of this Court, the touchstone is not credibility, but a question of law as to the legal sufficiency of proof. It is, therefore,

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stated the rule in even more emphatic language in Block v. Nathan Anklet Support Co., Inc., 2 Cir., 9 F. 2d 311, 313, "* * * but in such cases probability, even extreme probability, is not enough. The proof must be as absolute as in a criminal conviction; indeed, the rule comes nearly to this, that one must have contemporaneous records, verbal or structural.'"

[18] "Such oral testimony relating to a regularly patented device is open to grave suspicion and even though the witnesses be accepted as of the highest character the value of their testimony is open to serious question."

properly reviewable on appeal. **Baumgartner v. United States** (1944), 322 U. S. 665, 672, 64 S. Ct. 1240, 1244.[19]

The action of the Court below in resolving this issue on the basis of credibility is in direct conflict with the decision of this Court in **Smith v. Hall**, *supra*, where the Court found the testimony to be credible, but nevertheless insufficient in law.[20] Also the action of the Court below stands alone in accepting the uncorroborated testimony of a single witness as sufficient to establish prior use. This decision is inconsistent with the **prevailing** rule in other Circuits and the previous expressions of this Court.

It is, therefore, important that this Court reconcile this inconsistency and review the issue to the end that uniformity be established throughout the country on this important question in the patent law.

II. As to Substantive Issues.

On its merits, this case represents a clear debasement of the standard of invention sanctioned in recent cases of Courts of Appeals, based on earlier decisions of this Court. It involves no gadget, but complex engineering problems.

In this environment, the Court should not determine the question of **obviousness** by hindsight, but should apply objective standards. **Eibel Process Co. v. Minnesota & Ontario Paper Co.** (1923), 261 U. S. 45, 63, 43 S. Ct. 322, 328. **Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.** (1944), 321 U. S. 275, 279, 64 S. Ct. 593, 594. This Court has never indicated a deviation from the objective tests heretofore prescribed in these earlier decisions where the

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19 "* * * it is our view that the evidence does not measure up to the standard of proof which must be applied to this case."

20 "This oral testimony, if taken at its face value, would show that the Smith method was used in the Brooklyn incubator with eggs in staged incubation. But without corroboration, it is insufficient to establish prior use."

patent describes admittedly material improvements in the field of abstruce mechanics and where it is undisputed to be a patentable invention.

Based on the Opinion, concurred in by the Court of Appeals below, the conclusion of obviousness under Section 103 (35 U. S. C., § 103) appears to be inconsistent with interpretations of this section in other Circuits. This is a new section in the Patent Law, which has not been but should be interpreted against the background of this case.[21]

The Court below has rejected the definite guidelines as to what was "obvious" in this situation.[22] The Second Circuit decision is in direct conflict with the decisions in **Honolulu Oil Corp. v. Shelby Poultry Co.** (4th Cir., 1961), 293 F. (2d) 127, 131;[23] **Simplicity Mfg. Co. v. Quick Mfg. Inc.** (6th Cir., 1966), ... F. (2d) ..., 148 USPQ 243; and

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[21] "Reviser's Note. There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out."

[22] The Court of Appeals asserted that this refusal was because "the need had existed for a comparatively short time; several witnesses testified that they had never seen a front end loader prior to the early 1950's." This is contrary to the opinion of the District Court which found "a need of significant duration" (R. 7). Other circuits have not placed a time factor on the "need" if, indeed, that is an essential guidepost.

[23] "The defense of obviousness is founded upon the statute, which provides that a patent may not be obtained if, in the light of the prior art, the subject matter as a whole would have been obvious to a person having ordinary skill in the art. The Courts must provide an answer to that question, but they should not do so on the basis of subjective speculation as to what, after everything has been disclosed to it, might have seemed obvious to it. At least, when the record furnishes a basis for resort to objective standards, they should govern the court's determination."

Calhoun v. United States (Ct. of Cls., 1964), 339 F. (2d) 665, 667.[24]

Patentable combination should not be held obvious from inadequately established prior use, where objective tests support patentability.

The Safety Device clearance arm combination wherein the lifting arms provide for safe operation in their relation to the doors and windows, was held obvious and unpatentable in view of a loader allegedly built by Western Body & Hoist Company. Aside therefrom, the Court found this to be a material improvement in the art, and a patentable invention.

The Western Body Loader was sought to be established by the testimony of Mr. Livesley, partly by deposition and partly in open court. His testimony is full of inconsistencies. No competent proof was made of the drawing or of the photograph that were produced. The findings below, and indeed the decision of the Court of Appeals do not indicate any reliance on the documents for corroboration. This evidence clearly fails to establish proof beyond a reasonable doubt of the existence and use of the alleged prior device before the invention of the patent in suit.

The opinion of the District Court conceded that there had been a need for a safe dependable loader for a "significant duration" and that the shortcomings in the prior devices "could have been cured by adoption of the Plaintiff's variant."

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[24] "That the Christenson teaching was not considered obvious at the time of the invention is further supported by the fact that both the defendant and the commercial industry quickly adopted the Christenson invention and were willing to pay substantial royalties for the privilege of using it, and by the fact that the defendant admits it is imitating the invention to such an extent that it has no defense to the charge of infringement if the patent is valid."

Coupled with these findings is the undisputed evidence in the record that this Clearance Arm loader had a substantial impact on the industry. McDonald, Bowles and Western Body paid the tribute of their imitation to it when it appeared, and then when the patent in suit was issued, so far conceded the validity of this patent by abandoning manufacture of the copied devices. These are the same witnesses for the Defendant here of alleged prior use, but their actions speak more forcefully than claims of obviousness.

No one else has challenged the validity of this patent in the seven years of its existence except only the Defendant, and he, only after he had at first sought a license from Dempster. Even then, he obtained a license under this patent from a pretended claimant of title (R. 203).

These are guidelines that weigh heavily in support of the patentability of this combination with admittedly a new structure which the Court below conceded to be both a substantial improvement and a patentable invention. This invention should not be held to be obvious from a prior device even if established, which does not solve the safety requirements of the trade. This invention was the first and only solution until others have now appeared, including one by the very same Western Body, whose loader is relied upon by the Court of Appeals (see Petition for Rehearing, pp. 16-17). Other variants have now appeared attempting to solve the problem of "Safety".

The Court of Appeals, accepting, as it did, the uncorroborated testimony of Mr. Livesley, held that the clearance arm loader was "obvious" from this Western Body loader. The test of obviousness under 35 U. S. C., § 103, is an objective one; it is not a subjective test of invention. The objective guidelines here conceded or proven establish that the combination was not obvious. Obviousness by hindsight after the fact of making an invention is not

sufficient to overcome the statutory presumption of validity (35 U. S. C., § 282).

Section 282 of the Patent Law, which provides that a patent is presumed to be valid, would be rendered meaningless if indulgence in hindsight would be the means of striking it down where the whole trade has recognized the validity of the patent except only the Defendant, and where it has not only enjoyed great commercial success, but it has also stimulated others to solutions which were not previously evident.

This Court has heretofore recognized these guidelines as meeting the requirements for patentability. **Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.** (1944), 321 U. S. 275, 279, 64 S. Ct. 593, 594; **Eibel Process Co. v. Minnesota & Ontario Paper Co.** (1923), 261 U. S. 45, 63, 43 S. Ct. 322, 328. Reaffirmed in **United States v. Adams**, No. 55, decided February 21, 1966.

Thus, review should be granted in this case on a supervisory basis to "correct instances of improper administration" of the governing standard and prevent its erosion. **Rogers v. Missouri Pacific R. Co.** (1957), 352 U. S. 500, 509, 77 S. Ct. 443, 450. The Court has recognized there and in Rule 19, 1 (b) of this Court, that certiorari should be granted to insure application in practice of governing legal standards where there is substantial and clear evidence of their misapplication. As this Court has recognized, the standards are meaningless if not applied. This Court thus has a supervisory or policing function to perform.

This Court has heretofore condemned the patenting of "gadgets"[25] and many petitioners have sought review because of alleged involvement of "gadgets". It is equally as important that the Court approve the maintenance of proper standards in the abstruse field of mechanics and stresses (R. 157-164).

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[25] See **Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.** (1950), 340 U. S. 147, 156-157.

Other Circuits follow the rule that the test of obviousness under Section 103 is an objective one.[26] The guidelines for such objective tests are established and uncontradicted. Where available, they should be followed. It requires more than hindsight to overcome these objective tests according to Sections 103 and 282 of the 1952 Patent Act.

This case accordingly provides, in contrast to recent negative standards, positive standards of invention in abstruse mechanics. This factor furnishes an independent reason making this case an appropriate vehicle for the grant of certiorari.

CONCLUSION.

For the reasons stated, this Petition for Certiorari should be granted.

Respectfully submitted,

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March, 1966.

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[26] **Honolulu Oil Corp. v. Shelby Poultry Co.** (4th Cir., 1961), 293 F. (2d) 127, 131; **Hazeltine Research, Inc. v. Ladd** (D. C. D. C., 1964), 226 F. Supp. 459, affr. (App. D. C.), 340 F. (2d) 786.

APPENDIX A.

STATUTORY PROVISIONS.

§ 101. Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title. July 19, 1952, c. 950, § 1, 66 Stat. 797.

§ 102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other. July 19, 1952, c. 950, § 1, 66 Stat. 797.

§ 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, § 1, 66 Stat. 798.

§ 282. Presumption of validity; defenses.

A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.

The following shall be defenses in any action involving the validity or infringement of a patent and shall be pleaded:

(1) Noninfringement, absence of liability for infringement or unenforceability,

(2) Invalidity of the patent or any claim in suit on any ground specified in part II of this title as a condition for patentability,

(3) Invalidity of the patent or any claim in suit for failure to comply with any requirement of Sections 112 or 251 of this title,

(4) Any other fact or act made a defense by this title.

APPENDIX B.

Opinion of the Court of Appeals.

United States Court of Appeals
For the Second Circuit.

No. 24—September Term, 1965.

(Argued September 30, 1965, Decided November 3, 1965.)

Docket No. 29673.

Dempster Brothers, Inc.,
Plaintiff-Appellant,

—v.—

Buffalo Metal Container Corporation,
Defendant-Appellee.

Before:

Friendly and Kaufman, Circuit Judges,
and Herlands, District Judge.*

Appeal from an order of the District Court for the Western District of New York, Henderson, J., invalidating appellant's patent for a front end loader garbage pick-up and disposal device.

Affirmed.

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* Of the Southern District of New York, sitting by designation.

J. Preston Swecker, of Burns, Doane, Benedict, Swecker & Mathis, Washington, D. C. (Conrad Christel of Christel & Bean, Buffalo, N. Y.; Charles D. Snepp of Anderson & Snepp, Knoxville, Tenn.; and James P. Burns of Burns, Doane, Benedict, Swecker & Mathis, Washington, D. C., on the brief), for plaintiff-appellant.

Michael Beilewech, Jr., of Magavern, Magavern, Lowe & Beilewech, Buffalo, N. Y., for defendant-appellee.

Kaufman, Circuit Judge:

From the District Court's determination that its patent for a front end loader garbage and pick-up device was invalid, the plaintiff Dempster Brothers, Inc. ("Dempster") appeals. The District Court accurately and succinctly described the patent in suit as a device providing for

> "a front end type fork and arm loader which is mounted on a cab over engine truck chassis bearing a body adapted for holding refuse. The loading device permits a driver to engage a specially designed refuse container, dump the container, and return and disengage the container without leaving the truck cab. It utilizes two rigid, inverted 'U' or gooseneck configuration arms which are attached at their one end to the outer extremities of a rotatable, hydraulically actuated torque tube mounted on the truck chassis immediately behind the cab. Thus mounted, in their down position, the arms extend up, across the top, and down in front on either side of the cab. At the frontmost downwardly extending tips, the arms are joined by another rotatable hydraulically actuated torque tube to which two forks are attached; each fork being affixed near the outer extremity of

the torque tube, perpendicular to the tube and in a parallel relation to one another.

"On each of two sides of the refuse container, designed for use with this mechanism, is a type of sleeve affixed to the container, parallel with its base and designed for engagement by the aforedescribed forks. To engage the container the truck approaches the container with its forks in line with and directed into the container sleeves; the forks engage the sleeves, and the arms are then raised, arcing the container (which is kept relatively level by rotation of the torque tube to which the forks are affixed) up and over the refuse body. By rotating the forks, the container is dumped, the procedure is then reversed, and the truck proceeds to another container."

Dempster maintains that the defendant Buffalo Metal Container Corporation ("Buffalo") infringed claims 5, 6, 8, 9, 14, 15, 16, 18, 19 and 20 of the Patent issued to Dempster on August 18, 1959. Buffalo conceded below that if the patent were valid, it was guilty of infringement. Accordingly, the sole issue tried was the validity of Dempster's patent. Judge Henderson found that claims 6, 8, 9 and 20, relating primarily to the torque, fork, and container sleeve portion of the loader, were invalid on the basis of the prior art. Claims 5, 14, 15, 16, 18 and 19, relating in the main to the gooseneck configuration of the arms, were found to be an "obvious" improvement over the prior art.[1] We affirm.

In 1953, in keeping with an industry-wide movement to find a replacement for obsolescent rear end loaders, Demp-

[1] "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U. S. C., § 103.

ster began to manufacture front end loader refuse equipment. Its 1953 model (the "Holmes-Owen," or "H-O" loader) proved unsatisfactory in a number of respects. The witness Shea, Dempster's Vice-President, explained that the H-O loader's arms were not bent to clear the doors of the cab. As a result, the driver could be pinned inside the cab. Moreover, the arms were "jointed": when they had been raised to a certain point, they bent at the joint and threw the contents of the refuse containers into the body of the truck.[2] One of the crucial difficulties with this operation, Judge Henderson indicated, was that it created a "dead spot" during the container's arc from the ground to dumping position. In the event the operator failed to reverse the controls at precisely the correct moment, the operation could prove dangerous.

The "Clearance Arm," or "C-A" loader, the subject of the disputed patent, was developed by Dempster to cure these and other deficiencies. The principal advantages of this new model were: (1) the gooseneck arrangement of the arms over the cab provided added safety for the driver, making it impossible for him to be "pinned" inside the cab at any stage of the dumping procedure; (2) the rigid arms gave the operator of the truck continuous control throughout the dumping procedure; (3) the hydraulically actuated fork and arms allowed the container to remain level during most of the arc, thereby lessening the risk of spilling the contents; (4) the fork-sleeve attachment at the top of the sides of the container, rather than at the bottom, shortened the arc of the container and facilitated keeping the container level, thus diminishing the risk of accidents. The C-A model rep-

[2] A jointed arm is referred to in the trade as a "broken arm," whereas an arm which operates as a single unit is called a "straight arm" regardless of whether or not it has a bent configuration such as the Dempster gooseneck shape. To avoid confusion, we will employ the terminology "jointed arms" and "rigid arms," and further differentiate between rigid arms whose configurations are "straight" or "bent."

resented a significant improvement over the H-O. Indeed, we do not understand Buffalo to contend that the C-A loader would not have been patentable, had there been no other developments in the field subsequent to 1953.

I.

Judge Henderson found, as we have indicated, that the gooseneck configuration of the arms over the cab of the C.A. loader, although an important refinement providing a final solution to the problems posed by arms which did not clear the cab doors at all stages of the dumping process, was an obvious modification of the rigid arms utilized by other manufacturers in 1954 and 1955. Although it is not clear to us which prior art the District Judge relied on, we have no reason to reject Dempster's assertion that foremost among the prior art was a loader produced by the Western Body & Hoist Company ("Western") and sold to the P. D. Hamlin Disposal Company in 1954. This unit, photographs of which were identified at trial by the witness Livesley, President of Western, employed arms bent in a "double S" shape, passing over the wheels but under the cab doors when the arms were in the "down" position. In response to a question by the Court, Dempster's expert witness Hughes admitted that if presented with the Western loader and asked to solve the problem of clearing the doors at all stages of the dumping process, "I would be rather dumb if I didn't consider it [the gooseneck configuration later devised by Dempster] as a possibility."

We are mindful that in determining what was "obvious," infallible hindsight is much more common than precarious foresight. Judge Learned Hand explained this premise:

> "The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person 'having ordinary skill' in an 'art' with

which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general history of the means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it. There are indeed some sign posts: e. g. how long did the need exist; how many tried to find the way; how long did the surrounding and accessory arts disclose the means; how immediately was the invention recognized as an answer by those who used the new variant?''

Reiner v. I. Leon Co., 285 F. 2d 501, 503-04 (2d Cir. 1960), **cert. denied**, 366 U. S. 929 (1961); see **Lorenz v. F. W. Woolworth Co.**, 305 F. 2d 102, 104-05 (2d Cir. 1962).

While it is true that Dempster's solution was immediately heralded by its competitors as **the** answer, commercial success of a device, although certainly a relevant factor, does not by itself establish the validity of a patent. **Lorenz v. F. W. Woolworth Co.**, *supra*. Here, the need had existed for a comparatively short time; several witnesses testified that they had never seen a front end loader prior to the early 1950's. During this period, several manufacturers experimented with various arm configurations: the H-O broken arm; the rigid, straight arm; the Western ''double S'' arm. Although the progression was not lineal, each manufacturer sought to improve on his competitor's latest adaptations. We agree that the C-A loader's gooseneck arms, the last step in the evolution, was ''obvious'' from the prior art.

II.

Dempster argues vigorously that its patent claims relating to the torque, fork, and container sleeve segment of

the C-A loader were not anticipated by the prior art. In invalidating these claims, the District Judge relied on a rejected patent application filed by R. L. Aldredge in 1955, two vehicles manufactured by S. Vincen Bowles and sold, respectively, to Lawndale Disposal Company and Antelope Rubbish Company ("Bowles loaders"), a unit manufactured by Cook Bros. and sold to James E. Barnes ("Barnes loader"), and, finally, loaders produced by Western having features comparable to those of the C-A loader.

Dempster urges that there was insufficient proof of the existence of the prior art demonstrated by the Barnes and Bowles loaders. While we agree with Judge Henderson's observation that additional proof of prior art would have made the judicial task simpler, we are convinced the evidence substantiates the District Court's conclusions. It is true that the testimony concerning these loaders contained some inconsistencies, and documentation closer in time would have made the defendant's case stronger. But, viewing the record as a whole, we cannot say that the District Court's "complete satisfaction" with Buffalo's proof of prior art was clearly erroneous. In so holding, we are not unmindful that to the extent the evidence consisted of depositions and documents, "we are in as good a position as the trial court to examine it . . ." **Devex Corp. v. General Motors Corp.**, 321 F. 2d 234, 239 (7th Cir. 1963), **cert. denied**, 375 U. S. 971 (1964); see **Orvis v. Higgins**, 180 F. 2d 537, 539 (2d Cir.), **cert. denied**, 340 U. S. 822 (1950); cf. **Iravani Mottaghi v. Barkley Importing Co.**, 244 F. 2d 238, 248 (2d Cir.), **cert. denied**, 354 U. S. 939 (1957).

The appellant attacks the testimony of Barnes that in January 1956 he purchased from Cook Bros. a Reo truck with a front end loading device employing rigid arms curved to fit over the wheels of the cab and under the doors (similar to the Western unit described above) and hydraulically actuated forks at the end of the arms which fitted into sleeves on the lower part of the sides of detach-

able containers. This testimony is insufficent, it argues, because no contemporaneous documentation was introduced, and a large manufacturer such as Cook would normally be expected to have available pictorial and schematic drawings of units which it had produced. While such documentary proof would have been preferable, there is no absolute requirement that the evidence take this form. **Anderson Co. v. Trico Prod. Co.**, 267 F. 2d 700, 703 (2d Cir. 1959).[3] Accord, **Turner Dock Transfer Co. v. Terminal Engineering Co.**, 94 F. 2d 79, 80 (2d Cir. 1938). In any event, the record is not devoid of documentation, albeit non-contemporaneous. Barnes unequivocally identified a 1956 photograph of another Reo truck which he had purchased from Cook in April or May 1956, as substantially similar in appearance to his January 1956 purchase.[4] And, while Barnes admitted on cross-examination that the truck had been out of his possession for a period of time and the forks had been repaired, in response to questioning by the court he adhered to his earlier testimony that the photographs were reasonable representations of the truck he purchased in January 1956. The court's "complete satisfaction" with the proof of the prior art, including the Barnes loader, implies a finding that Barnes' testimony was credible, notwithstanding inconsistencies. For us to reject this assessment of credibility out of hand, would be to invade the province of the trier of fact. See **Oil Transport Corp. v. Amboy**

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[3] We are not unaware that on rehearing, we vacated our original decision on the ground that the prior public use had not been proved by clear and convincing evidence. However, we expressly noted that not only had the evidence of prior use been entirely oral, but also that "that testimony is by no means abundant." 267 F. 2d, at 705.

[4] Other documentary evidence of the purchase was also introduced: a conditional sales agreement for the Reo vehicle, a letter from the motor vehicle department, and a motor vehicle registration form. But, since the descriptions of the vehicle referred to in these exhibits are vague, we place little reliance on them.

Towboats, Inc., 193 F. 2d 264 (2d Cir. 1952); **Orvis v. Higgins**, *supra*; **Scott v. Spanjer Bros., Inc.**, 298 F. 2d 928 (2d Cir. 1962) (jury). See generally Hazard, **After the Trial Court—The Realities of Appellate Review**, in The Courts, the Public, and the Law Explosion 60 (Harry W. Jones ed. 1965).

Bowles' deposition provides additional proof of prior art. Bowles stated that in 1955 he built loaders also employing hydraulically actuated forks fitting into sleeves on detachable containers and sold them to Lawndale Disposal Co. and Antelope Rubbish Co. He too identified noncontemporaneous photographs as accurate portrayals of the relevant portions of the loaders as they existed in 1955. As we have already indicated, since credibility played part in the trial court's assessment of this evidence, we have a wider scope of review. Nevertheless, we are disinclined to set aside the finding of fact, carefully arrived at below and supported by deposition testimony that the relevant features of the Bowles loaders existed in 1955.[5]

Finally, Dempster argues that even if the Barnes and Bowles loaders existed as depicted in the 1963 photographs on or before May 28, 1956, they did not meet the claims of the patent for the C-A loader, and therefore cannot be "the [same] invention . . . in public use . . ." within the meaning of 35 U. S. C., § 102 (b). For example, it says, the forks on the Barnes loader fitted into sleeves near the bottom of the container, while the forks on the C-A model

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[5] We have carefully examined the record and noted the factors which Dempster contends reflect adversely on the proof that the Bowles loaders existed in 1955, such as the minor inconsistencies between the depositions of Bowles and Leon Mick (part owner of both Lawndale and Antelope) and Bowles' possible motivation for bias (an infringement suit by Dempster against him was settled by consent decree). We are not persuaded that these circumstances sufficed to destroy Bowles' clear testimony on direct examination so that we would be warranted in overriding the lower court's finding.

picked it up near the top, providing greater stability and safety. At the very least, it is urged, the case should be remanded to the trial court for more detailed findings on the precise method of operation of the Barnes and Bowles pick-up mechanisms. Although more specific findings of fact would have been helpful on our review, a remand is unnecessary in this case. For, even if we accept *arguendo* Dempster's contention that its pick-up device was a substantial improvement over the prior art, we believe that its modifications were "obvious," based on the criteria already discussed in connection with the gooseneck arms.

Since we consider the prior art demonstrated by the Bowles and Barnes loaders to have been adequately proven, we find it unnecessary to consider Dempster's further contentions that the trial court misread the Aldredge patent or that the claims of its patent related to the pick-up mechanism were not met by the Western loader.

Affirmed.

APPENDIX C.

Order Denying Petition for Rehearing En Banc. Petition for Rehearing.

Treating the petition as a petition for rehearing by the panel and a suggestion for rehearing in banc, as provided by Rule 25 (b) of this Court, we deny the petition for rehearing by the panel.

H.J.F.
I.R.K.
U.S.C.JJ.

W.B.H.
U.S.D.J.

Dec. 13, 1965.

APPENDIX D.

Opinion of the District Court. Decision and Order.

(Entered December 22, 1964.)

On August 18, 1959, United States Letters Patent No. 2,900,096 was issued to the plaintiffs, Dempster Brothers, Inc. and George R. Dempster, for an invention in front-end loaders made by George R. Dempster jointly with William A. Herpich. The interest of William A. Herpich was assigned to the plaintiff, Dempster Brothers, Inc., prior to the issuance of the patent. This action, alleging infringement of that patent, was filed on December 4, 1959. Plaintiffs initially relied on claims 5, 6, 8, 9, 12, 14, 15, 16, 18, 19 and 20. On trial, claim 12 was withdrawn. Trial has been limited to the issues of validity and infringement, and on the latter issue the defendants have conceded that plaintiffs' patent, if valid, was infringed by all of the accused units except one.

As produced and demonstrated to the court, the device covered by the patent in suit is a front-end type fork and arm loader which is mounted on a cab over engine truck chassis bearing a body adapted for holding refuse. The loading device permits a driver to engage a specially designed refuse container, dump the container, and return and disengage the container without leaving the truck cab. It utilizes two rigid, inverted "U" or gooseneck configuration arms which are attached at their one end to the outer extremities of a rotatable, hydraulically actuated torque tube mounted on the truck chassis immediately behind the cab. Thus mounted, in their down position, the arms extend up, across the top, and down in front on either side of the cab. At the frontmost downwardly extending tips, the arms are joined by another

rotatable hydraulically actuated torque tube to which two forks are attached; each fork being affixed near the outer extremity of the torque tube, perpendicular to the tube and in a parallel relation to one another.

On each of two sides of the refuse container, designed for use with this mechanism, is a type of sleeve affixed to the container, parallel with its base and designed for engagement by the aforedescribed forks. To engage the container the truck approaches the container with its forks in line with and directed into the container sleeves; the forks engage the sleeves, and the arms are then raised, arcing the container (which is kept relatively level by rotation of the torque tube to which the forks are affixed) up and over the refuse body. By rotating the forks the container is dumped, the procedure is then reversed, and the truck proceeds to another container.

Initially, one patent cited in the patent in suit merits comment. Putting aside for the moment consideration of the configuration of the arms on the plaintiffs' device, the patent examiner's consideration and rejection of the patent issued to Aldrich et al. on May 5, 1959 (filed January 19, 1955, Patent 2,885,101) is quite disconcerting (App. 1). That device appears to operate much as would a rigid arm loader employing a torque tube and forks to accomplish leveling and the dumping process. While designated to provide for limited gravitational leveling, Aldrich's device possesses the control feature absent in the Holmes-Owen broken-arm loader and generally functions as does the plaintiffs' device.

The similarity can be seen by reference to figures 1 and 8 of the patent in suit (App. 2). In figure 1 a completely rigid arm is employed with a container connecting means permitting the container to swing freely until engaged by dumping means affixed to the truck body. Figure 8 depicts the device demonstrated to the court as hereinbefore

described. Envisioning figure 1 of the patent in suit with container engaging means locking the container relative to arm 16 and with rotating means affixed to arm 16 (again putting aside consideration of the configuration of the arms), the similarity to Aldrich's device becomes apparent.

Thus, both the plaintiffs' device, as demonstrated to the court, and Aldrich's device, permit leveling and dumping; the plaintiffs' device through rotation of the torque tube and attached forks—Aldrich's device through actuation in either direction of the extension arms. True, Aldrich's device, by its container locking means, permits a certain amount of free rotation and resulting leveling without independent driver activation. In plaintiffs' device rigidity at the frontmost portion of the arms is provided by use of a torque tube, while Aldrich uses a pivot for tilting and a cross member (25') for rigidity. Aldrich also employs leverage principles to reduce stress on the activating mechanism controlling the main arms. In essence, however, it appears that the plaintiffs have employed simpler known means than those utilized by Aldrich. (It should be noted also that Aldrich's patent depicts an arm with a bend in it to elementally avoid the cab doors and the truck wheels.) Several examples of the use of simpler means in similar devices are found in the prior art.

At the outset of this discussion it is appropriate for the court to acknowledge that it could have benefited additionally from the production of certain prior art witnesses in person and also may have been further enlightened by the testimony, in one form or another, of persons who have been mentioned by these witnesses. However, in fairness, the court cannot be blind to the disparity in financial resources which is so evident in this case.[1] View-

[1] See generally: Business Aggression Under the Patent System, The University of Chicago Law Review, Vol. 26, p. 353 (1959).

ing the record as a whole, the court is completely satisfied with the defendants' proof of prior art.

While the plaintiffs claim that as early as November 8, 1955, they had struck upon the inverted "U" or gooseneck configuration arm, the pick-up means responding to claims 6, 8, 9 and 20 appear to have been added some time later—subsequent to the prior art relevant to these features. Employing rigid arms and equipped with fork means for detachable engagement with containers no later than 1955 and early 1956 were two vehicles manufactured by S. Vincent Bowles and used by Lawndale Disposal and Antelope Rubbish, and a third unit manufactured by Cook Bros. and used by James E. Barnes. Other examples of devices having comparable features are found in units produced by Western Body and Hoist Company (formerly known as Progressive Body Works). On the basis of the prior art, the court finds claims 6, 8, 9 and 20 to be invalid.

Claims 5, 14, 15, 16, 18 and 19 address themselves particularly to the inverted "U" or gooseneck configuration arm. Initially it should be understood that the plaintiffs' device, in function, is identical to a straight-arm loader, equipped with the same or similar means for detachable engagement with independent containers. In fact, considering the stresses to which the gooseneck arms are subjected by their radical configuration, the design is inferior to straight-arm loaders or loaders having shorter arms with less severe bends. By reason of their configuration, however, the danger of damage to the truck cab doors and side mirrors is eliminated, some operational advantage gained, and an additional factor of safety to the driver-operator achieved.

The defendants claim that bending of the arms around the area sought to be avoided was a most obvious solution to the problem which the plaintiffs were trying to solve.

Because of the simplicity of the solution, this indeed is an inviting view. However, for this very reason the court must be mindful of the following admonition by the late Judge Learned Hand in **Reiner v. I. Leon Co.**, 285 F. 2d 501, 503-504 (2d Cir. 1960):

> "The test laid down is indeed misty enough. It directs us to surmise what was the range or ingenuity of a person 'having ordinary skill' in an 'art' with which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general history of the means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it. There are indeed some sign posts: e. g., how long did the need exist; how many tried to find the way; how long did the surrounding and accessory arts disclose the means; how immediately was the invention recognized as an answer by those who used the new variant?"

In applying these guides it is important to keep in mind limitations on the plaintiffs' contribution. The record indicates a need, of significant duration, for a practical front-end loading waste collection system operable essentially by one man. However, it must be remembered that just prior to the plaintiffs' development a number of most significant contributions appeared in the art. The significance of these contributions is perhaps best illustrated by a comparison with a notable failure among earlier endeavors.

The Holmes-Owen loader, which was marketed by the plaintiffs, utilized a true broken-arm principle (it would appear that the broken arm was used to shorten the arc that would otherwise be traversed by a rigid arm). A

characteristic of this broken arm was a dead-spot in control when the two portions of the arm were perpendicular with the ground and in line with each other. Thus, in operation, the container had to achieve enough momentum in arcing to carry it through the dead-spot and, once through, had to be caught by quick reversal of the controls. Needless to say an inexperienced operator could encounter some rather startling situations. Another serious consequence of its use was the virtual imprisonment of the driver except when the arms were in a vertical position. Therefore, if for one reason or another the driver had difficulty in engaging a container, he could not step from the cab to remedy the situation; instead he would have to back off from the container, raise the arms, and attempt to make the necessary adjustments. Because the device was so unsatisfactory, the plaintiffs began exploring unorthodox concepts (App. 3) from which it appears the gooseneck eventually evolved.

Shortly before the plaintiffs hit upon their idea, smaller outfits, through combination of elements common in industry and the construction trades, struck the fundamental concept, namely, use of the rigid, rotatable main arms, the detachable container, and container engagement and rotating means. Generally, these devices proved quite satisfactory and their shortcomings, which could have been cured by adoption of the plaintiffs' variant, had yet to be recognized. Thus, due to the newness of these devices the court does not believe that the traditional guideposts can be said to lend any substantial support to the plaintiffs' claim of invention. Therefore, striving as best it can to avoid employing hindsight, the court must decide the question of obviousness.

Considering the history of and progress in this art, the court cannot believe that a skilled mechanic, given a loader with rigid arms bent to clear the wheels or, for that matter, a loader with a completely straight arm encumbering

the wheels of the vehicle advised of the device's general satisfactory performance and told that the arms prevented turning of the wheels, posed a threat of damage to open doors and the side mirror, and posed a further threat of injury to the driver, would not soon consider bending the arms to clear these areas. Perhaps, as Mr. Hughes, plaintiffs' witness, testified (Tr. 706-709), an engineer might be inclined to immediately reject this solution because of the stresses involved in such arms. Nevertheless, the court finds that the variant would readily occur to either an engineer or skilled mechanic in the art. In short, the state of the prior art was such as to render the plaintiffs' variant obvious to a mechanic appreciating the problem.

Judgment, therefore, will be entered for the defendants. So ordered.

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In The

Supreme Court of the United States

October Term, 1966

No. 1106

DEMPSTER BROTHERS, INC., et al.,

Petitioners,

vs.

BUFFALO METAL CONTAINER CORPORATION, et al.,

Respondents.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Second Circuit

BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

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In The

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October Term, 1966

No. 1106

DEMPSTER BROTHERS, INC., et al.,

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vs.

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

We oppose the granting of the petition because we maintain:

1. That this Court has not ruled that uncorroborated oral testimony to prove prior art is legally insufficient per se;

2. That even if it has, the question is not squarely presented here since there is corroboration of the oral testimony which is challenged by Petitioners together with proof of other prior art not completely identified or discussed by the courts below;

3. That the decision below is not in conflict with the decisions of this Court nor with decisions of other circuits as to the quantum of proof necessary to establish prior art.

STATEMENT OF FACT

We take emphatic issue with Petitioners' repeated assertion that the Court below found that the C-A loader, the device in question, represents a patentable combination, but that the patent was barred because of certain prior use devices. Petitioners' base their assertion on the following sentences taken from the decision of the Court below (Pet. App. 8a):

> "The C-A model represented a significant improvement over the H-O. Indeed, we do not understand Buffalo to contend that the C-A loader would not have been patentable, had there been no other developments in the field subsequent to 1953."

We hardly consider these sentences a flat finding of patentability. We have not and will not admit patentability of this device since the prior act even in 1953 was such that the improvements claimed in the C-A loader were obvious.

ARGUMENT

POINT I

This Court has not ruled that uncorroborated oral testimony to prove prior art in patent cases is legally insufficient.

Petitioners claim that *Smith v. Hall,* 301 U.S. 216, 222, 57, S. Ct. 711, 714, affirming earlier decisions in *Eibel Process Co. v. Minnesota and Ontario Paper Co.* (1923), 261 U.S. 45, 45 S. Ct. 322; *Deering v. Winona Harvester Works* (1894), 155 U.S. 286, 15 S. Ct. 118; and *The Barbed Wire Patent* (1892) 143 U.S. 275, 12 S. Ct. 443, is authority for the proposition that uncorroborated oral testimony is insufficient in law to prove prior art in patent cases.

We disagree. Beginning with *The Barbed Wire Patent,* supra, these earlier decisions gave warning of the danger of such testimony but did not state that it would be legally insufficient. *The Barbed Wire Patent,* supra, requires proof that is "clear, satisfactory and beyond a reasonable doubt". *Deering v. Winona Harvester Works,* supra, requires that the evidence be "so cogent as to leave no reasonable doubt in the mind of the court that the transaction occurred substantially as stated". In *Eibel Process Co. v. Minnesota and Ontario Paper Co.,* supra, states that "evidence to prove prior discovery must be clear and satisfactory."

In *Smith v. Hall,* supra, the court had reference to specific oral testimony given in *that* case where it stated that "without corroboration, it is insufficient to establish prior use", immediately cited *Barbed Wire, Deering,* and *Eibel* and went on to agree that the very same oral testimony was, after all, amply corroborated. The proposition so earnestly pressed by Petitioners is, therefore, not the law of *Smith v. Hall.*

Moreover, this Court, in *Corona Cord Tire Co. v. Dovan Chemical Corporation* 276 U.S. 358, 381, 382, 48 S. Ct. 380, accepted uncorroborated oral testimony of a single witness who testified as to shipping prior art devices to a customer. The Court pointed out that this witness was not seeking a patent, had no pecuniary interest in the result of the case, and then stated:

> "The fact that he is the only witness is not fatal or any reason for denying the weight of his testimony in connection with other circumstances."

POINT II

There is corroboration of the challenged oral testimony of prior use herein together with proof of other prior art devices.

Even assuming *arguendo* that Petitioners are correct in their interpretation of *Smith v. Hall,* supra, this case does not present the question squarely. Barnes identified a May, 1956 photograph as representative of his January 31, 1956, purchase of his prior art garbage truck. In addition, Barnes produced synchronous purchase and financing documents covering this truck. It is true that the Court below stated that it placed little reliance thereon because of vague descriptions of the device contained therein, but it did not completely ignore these documents. Further, Barnes owned and possessed this device on the day he gave his testimony thereon in open Court (R. 244).

As to the Bowles unit, while neither Court below mentioned it, other documentation besides the photographs were introduced into evidence such as an invoice (R. 273) and a conditional sales contract (R. 299) both contemporaneous with the matters in question. Further, as in the case of the Barnes unit, the prior art device was owned and in the possession of the witness Bowles at the time he gave his testimony thereon in deposition form. As a matter of fact, Bowles' testimony and that of Mick, who originally purchased the unit from Bowles in 1955, was taken at Bowles' office with the truck parked outside in Bowles' yard (R. 268). The witness Mick was taken outside to the truck whereupon he identified it and confirmed the serial number on it as being the same as on the conditional sales contract hereinbefore mentioned (R. 301).

As to the Western Body and Hoist Company devices, the decision below refers only to photographs of one such unit, the truck having the "S"-shaped arms. Other documentation was introduced on this device, including a job sheet. In addition, documented testimony was given on many other Western Body prior art devices including those depicted in the Appendix (Pet. App. 345).

Other evidence of prior art was put into the record which was not challenged by Petitioners but which is not all specifically set forth in the decisions of the two Courts below. Therefore, since there is corroboration of the challenged oral testimony and other prior art, we submit that the question is not squarely presented. This Court has always insisted on a relevant factual record so as to relate its decision thereto. We do not have that here.

POINT III

The decision below is not in conflict with decisions of this Court nor with decisions of other circuits.

As we have heretofore submitted, this Court has never stated that uncorroborated oral testimony as to prior art is legally insufficient per se.

What is clear and convincing evidence in a case must be determined against the context of the patent, the prior art and the particular circumstances of the case. It should not be the prisoner of a formula and is not an absolute to be considered in a vacuum.

A careful reading of each of the cases cited by Petitioners as being in conflict with the decision of the Court below, reveals that the courts in those cases weighed each item of proof in such fashion. The context of the patent, the complexity of the device, creditibility of witnesses, lapse of

time, contradictory evidence and all the other circumstances of the case were taken into consideration in determining whether proof was clear and satisfactory. Each case turned on its own facts.

We cannot find any departure by the Court below from the requirements of proof of prior art as established by this Court, nor can we find any conflict (much less a *real* conflict) between the decision at hand and the decisions of the other circuits.

ON THE MERITS

In view of the Court's recent decision in *Graham v. John Deere Co.* of Kansas City 383 U.S. 1, 86 S. Ct. 684, we need not reply to Petitioners' position on standards of invention and obviousness. Their C-A loader does not measure to the standards required by this Court.

CONCLUSION

The petition for certiorari should be denied.

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IN THE

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No. 1106

DEMPSTER BROTHERS, INC., ET AL., *Petitioners,*

v.

BUFFALO METAL CONTAINER CORPORATION, ET AL., *Respondents*

REPLY BRIEF FOR PETITIONERS

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Respondents

REPLY BRIEF FOR PETITIONERS

We desire to clarify some of the points that appear to be misstated in the Respondents' Brief.

The Respondents refer to the decision of this Court in *Corona Cord Tire Co.* v. *Dovan Chemical Corp.* (1928), 276 U.S. 358, 48 S. Ct. 380, as accepting "uncorroborated oral testimony of a single witness". The case does not support the Respondents' proposition.

There is extensive discussion of corroboration as to the identity of the prior article, in the opinion of Mr. Justice Taft, on pages 380-383 of 276 U.S., pages 386-387 of 48 S. Ct. If there were any doubt about adequate corroboration of Dr. Kratz's testimony, this would have been disspelled by the statement which follows immediately after the sentence quoted in the Respondents' Brief, wherein the opinion describes Dr. Kratz's activities and testimony:

> "supported by the evidence of Dr. Russell, his chief, and by the indubitable records that are not challenged".
>
> (p. 382 of 276 U.S., p. 387 of 48 S. Ct.)

Therefore, the *Corona Tire* case, decided nine years before *Smith* v. *Hall,* is not in point.

The respondents urge that the rule requiring corroboration, so clearly expressed by this Court in *Smith* v. *Hall,* was not the rule of that case because the Court went on to find "uncontradicted evidence" of the identity of the prior use device, in support of the oral testimony.[1]

In *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.* (1923), 261 U.S. 45, 43 S. Ct. 322, there was no docu-

---

[1] "Hastings is abundantly corroborated by disinterested witnesses and contemporary photographs and publications describing it. The principal witnesses are Lieber, who furnished the money for the enterprise, Peabody, the electrical contractor who installed the fan and other electrical equipment of the incubator, and Hickox, manager of the local electric light company which supplied the current for the incubator. In 1912, Hickox took photographs of the incubator in operation, and prepared a written description of it. These were produced at the trial."

(p. 716 of 301 U.S.)

mentary corroboration of the oral testimony and the Court rejected it for that reason.[2]

The Respondents still argue that here there was corroboration for the oral testimony of Barnes and Bowles, notwithstanding that the Barnes documents were rejected by the Court of Appeals (footnote 4), and Mick's testimony was so completely lacking in corroborative value that it was not even mentioned by either Court below.

The Court of Appeals found no corroboration, but accepted the uncorroborated oral testimony of both Barnes[3] and Bowles[4] as to the identity of the prior use devices. This is insufficient in law.

Mr. Barnes' identification of a photograph of a different device, as allegedly taken in May, 1956, is no more acceptable proof than was his identification of the 1963 photographs. Since there was no other proof

---

[2] "It is true that some witnesses testify that they realized, before Eibel's application, that speeding up the stock to equal velocity with the wire would solve the difficulty and aid the speed. *But there is not a single written record, letter, or specification of prior date to Eibel's application that discloses any such discovery by any one, or the use of the pitch of the wire to aid the speed of the machine. The oral evidence on this point falls far short of being enough to overcome the presumption of novelty from the granting of the patent.* The temptation to remember in such cases and the ease with which honest witnesses can convince themselves after many years of having had a conception at the basis of a valuable patent, are well known in this branch of law, and have properly led to a rule that evidence to prove prior discovery must be clear and satisfactory. Barbed Wire Patent Case, 143 U.S. 275, 284, 12 Sup. Ct. 443, 36 L.Ed. 154; Loom Co. v. Higgins, 105 U.S. 580, 591, 26 L.Ed. 1177." (Italics ours)
(p. 60 of 261 U.S., p. 327 of 43 S.Ct.)

[3] "Barnes testimony was credible, notwithstanding inconsistencies."

[4] "Bowles' deposition provides additional proof of prior art."

to confirm the date of the photograph allegedly taken in May, 1956, and the District Court admitted it only as exemplary of the oral testimony, this clearly is not corroborative.

The Respondents' argument here that there was corroboration was rejected by the Court of Appeals which, nevertheless, affirmed the acceptance of uncorroborated oral testimony of a single witness as to the identity of the prior use device, Barnes as to one device; Bowles as to another; and Livesley as to a third device. These clearly are insufficient under the rule of law of this Court and of at least five Circuits.

Insofar as the decision below rejected certain of the claims of the patent in suit for obviousness, it acted contrary to this Court's decision, subsequently announced in *United States* v. *Adams,* 383 U.S. 25, 86 S. Ct. 708. That portion of the decision should be reversed on the authority of that case.

Respectfully submitted,

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No. 1106

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v.

BUFFALO METAL CONTAINER CORPORATION, ET AL., *Respondents.*

PETITION FOR REHEARING OF ORDER ON PETITION FOR WRIT OF CERTIORARI

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PETITION FOR REHEARING OF ORDER ON PETITION FOR WRIT OF CERTIORARI

Petitioners respectfully pray that this Court grant a rehearing of its order, dated May 16, 1966, denying the petition for writ of certiorari, to review the judgment of the United States Court of Appeals for the Second Circuit.

This petition for rehearing is filed under Rule 58, par. 2, and presents substantial grounds available to Petitioners, although not previously presented in the original petition, and, in part, intervening circumstances of substantial or controlling effect.

GROUNDS FOR REHEARING OF PETITION FOR CERTIORARI

1. The decision of the Court of Appeals for the Second Circuit is in conflict with decisions of United States District Courts on the same patent.

2. An intervening decision of the Third Circuit on substantially identical facts is in conflict with the decision of the Second Circuit in this case.

3. This Court was misled by the failure of the District Court to make adequate and specific findings of fact as to prior uses.

4. Litigation elsewhere, with a resulting conflict of decision, is improbable because three large manufacturers stopped making the accused devices in recognition of the patent in suit and the trade has resorted to articulated, cumbersome front end loaders (see Appendix, p. 1a).

I. THE DECISION OF THE COURT OF APPEALS FOR THE SECOND CIRCUIT IS IN CONFLICT WITH DECISIONS OF UNITED STATES DISTRICT COURTS ON THE SAME PATENT.

On December 4, 1959, Civil Action No. 1264-59-WM, was filed by the Plaintiffs on patent No. 2,900,096, against S. Vincen Bowles and S. Vincen Bowles, Inc., and on which final judgment was subsequently entered by the United States District Court for the Southern District of California, Central Division, sustaining the validity of this patent and holding that certain claims thereof are infringed. This judgment is valid and subsisting. A copy thereof was marked in this case as Ex. P. 286.

Also on December 4, 1959, Civil Action No. 2336-SD-C, was filed by the Plaintiffs on Patent No.

2,900,096, against Joseph E. McDonald et al., and on which final judgment was subsequently entered by the United States District Court for the Southern District of California, Southern Division, sustaining the validity of this patent and holding that all claims thereof "are good and valid in law".

Even though these be decisions of District Courts, they are final decisions in those cases and remain as standing decisions. There is just as much need for reconciling them with the final decision in the Second Circuit, as if they were by the Court of Appeals.

Cases in which this Court has granted certiorari to resolve conflict of decision of different courts on the same issue include the following:

Sanford v. *Kepner* (1952), 344 U.S. 13, 73 S.Ct. 75;

Stelos Co. v. *Hosiery Motor-Mend Corp.* (1935) 295 U.S. 237, 55 S.Ct. 746;

Universal Oil Products Co. v. *Globe Oil & Refining Co.* (1944), 322 U.S. 471, 64 S.Ct. 1110.

II. AN INTERVENING DECISION OF THE THIRD CIRCUIT ON SUBSTANTIALLY IDENTICAL FACTS IS IN CONFLICT WITH THE DECISION OF THE SECOND CIRCUIT IN THIS CASE.

On May 18, 1966, the Court of Appeals for the Third Circuit decided appeal No. 15,360, *Jones Knitting Corporation, et al.* v. *Morgan, et al.*, — F.(2d) —, 149 USPQ 659.

One of the principal defenses to the validity of the patent on the knitted fabric was the prior use of a similar fabric. The alleged infringer sought to prove the use of a similar fabric by one Anderson, with two corroborating witnesses who were co-employees at the time the fabric was allegedly used. However, because

of the heavy burden resting on the infringer and the lack of corroboration, this was held by the Court of Appeals not to meet the requirements of this Court for proof of prior use. The Court of Appeals reversed the District Court and held the patent valid.

The circumstances and character of evidence involved in the Jones case are closely parallel with those involved in the Second Circuit and yet the Third Circuit following decisions of this Court held that the evidence was not sufficient, directly contrary to the decision of the Second Circuit. This intervening decision indicates a need for review by this Court for clarification of this branch of the law.

III. THIS COURT WAS MISLED BY THE FAILURE OF THE DISTRICT COURT TO MAKE ADEQUATE AND SPECIFIC FINDINGS OF FACT AS TO PRIOR USES.

In denying the Petition for Certiorari, this Court evidently was misled into an assumption that there was corroboration for the oral testimony of prior use, which this Court and other Circuits have always required for proof. The Record does not support such assumption, but shows the contrary.

The circumstances under which a case is presented to a court of appeals are materially different from those of a trial. Here the trial consumed some eleven days, with extensive briefs following. In the Court of Appeals the review was limited to a very restricted brief and a curtailed argument measured in minutes. The reviewing court should not make findings and amend them, under those circumstances. The Petitioners are thus deprived of due process.

Rule 52 of the Federal Rules of Civil Procedure requires that the Court "find the facts specifically". Where the findings of fact are insufficient to support

the judgment, this Court has reversed the action to require that this be done. *Kelley* v. *Everglades Drainage District* (1943), 319 U.S. 415, 420, 63 S.Ct. 1141, 1144;[1] *Hatahley* v. *United States*, (1956), 351 U.S. 173 76 S.Ct. 745.

The District Court wrote an opinion, in which it gave only a brief summary of the evidence, but as to the turning point of the case, the prior uses, it made no findings of fact, but only a conclusion of law that the Court was "completely satisfied with the defendants' proof of prior art" (R. 5), even though much of the testimony was by deposition. There was no analysis of the testimony, no findings of fact as to corroboration, no reference to documentary evidence.

The Court of Appeals reviewed the evidence somewhat more at length, but it is deprived at the very least of the findings of fact prescribed by Rule 52. The Court of Appeals admitted that:

> "Although more specific findings of fact would have been helpful on our review, a remand is unnecessary in this case."

What the Court of Appeals was doing in thus rejecting the demand for more specific findings of fact was to substitute its own summary review of the evidence for the trier of fact, the District Court. The Court of Appeals rejected much of the consideration of the District Court as to this patent, the very foundation on which the District Court's decision was predicated,

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[1] "To support such determinations, there must be findings, in such detail and exactness as the nature of the case permits, of subsidiary facts on which the ultimate conclusion of fairness can rationally be predicated.

"The findings in the present case fall short of that requirement."

leaving only the bare prior use devices, but without any findings of fact as to those prior use devices, that they were sufficient to support the decision.

There was no corroboration here. This Court may have assumed and been misled by the vague and indefinite lack of adequate findings of the District Court, and the opinion of the Court of Appeals.

To find that "the Court is completely satisfied with the Defendants' proof of prior art" (R. 5) is merely a legal conclusion, but aside from general reference to particular devices, that is as far as the District Court goes in complying with Rule 52. It is not a compliance and the Court of Appeals should have remanded the case, as requested, which would have given the District Court an opportunity to analyze the evidence of prior use in the light of the modifying decision of the Court of Appeals. *United States* v. *United States Gypsum Co.*, (1948) 333 U.S. 364, 395, 68 S.Ct. 525, 542.[2]

At the same time, it would have revealed to this Court that there was no corroboration for the testimony of the witnesses as to these prior uses. This would have revealed that the witnesses are without the contemporaneous documentary evidence necessary according to decisions of this Court and of the Circuit Court of Appeals to sustain proof of prior use.

So, too, the decision of the Court of Appeals is couched in vague language as to infer and thus may have resulted in misleading this Court into the assump-

[2] "A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed."

tion of corroboration, when there was none. Without corroboration, the decision cannot stand. It is against all authority. It is important, therefore, that there be clear delineation of the corroborating documents that are held to support the oral testimony. These should not be left to inference, assumption, or indefiniteness.

This decision, of course, is not a bar to a subsequent suit in a different circuit on the same patent. The prior uses would still need to be established in such cases by the defendants. With the vagueness of the findings here, it would be difficult for the Court in each case to determine what corroborating evidence is presented here to meet the legal requirements. Moreover, by the time each other case reaches trial, evidence of proving or disproving corroboration may be unavailable. This is an important reason for review of this case now.

IV. LITIGATION ELSEWHERE, WITH A RESULTING CONFLICT OF DECISION, IS IMPROBABLE BECAUSE THREE LARGE MANUFACTURERS STOPPED MAKING THE ACCUSED DEVICES IN RECOGNITION OF THE PATENT IN SUIT AND THE TRADE HAS RESORTED TO ARTICULATED, CUMBERSOME FRONT END LOADERS.

This Court has recognized the propriety of granting petitions for certiorari even in the absence of a conflict of decision, where it is improbable that there will be a conflict of decision in different circuits. *Schriber-Schroth Co.* v. *Cleveland Trust Co.* (1938), 305 U.S. 47, 50, 59 S.Ct. 8, 10.

The Defendant is the only manufacturer presently making the gooseneck-type front end loader as an infringement of the patent in suit. Three other manufacturers stopped making this type of loader in recognition of this patent, two of whom stand under consent judgments that this patent is valid.

Other manufacturers, except this Defendant, have resorted to the making of complex articulated-type of expensive equipment which is not accused to be infringements of the patent (see Appendix, p. 1a).

In view of the direction of the trash and refuse equipment industry in thus adopting other and more complicated equipment, it would be of benefit to the welfare of the whole country for the Court to review this case to the end of determining finally whether or not the patent in suit is valid or was anticipated by prior uses devices. Otherwise, the patent in suit would continue to stand as a threat to further litigation and may keep the industry from using the form of front end loader (Petition, pp. 5, 7), which is of so great benefit as established by its commercial success, and when compared with the complex devices now in use by others in the industry, as has been noted above (Appendix, p. 1a).

Respectfully submitted,

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June, 1966.

Certificate of Counsel

I hereby certify that the foregoing Petition for Rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58 of the Rules of this Court.

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APPENDIX